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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,730	12/26/2000	Yoshikazu Kobayashi	369252/99	1971
30743 7590 02/12/2007 WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			EXAMINER SCHEIBEL, ROBERT C	
			ART UNIT	PAPER NUMBER
			2616	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/745,730

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Robert C. Scheibel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- Examiner acknowledges receipt of the Request for Continued Examination (RCE) received 11/24/2006.
- Claims 1-11 have been cancelled with this amendment.
- Claim 12 is currently amended.
- Claims 13-18 have been newly added.
- Claims 12-18 are currently pending.

Response to Arguments

1. Applicant's arguments, see pages 4-6, filed 11/24/2006, with respect to the rejection of claim 12 under 35 U.S.C. 103(a) have been considered but are moot in view of the new grounds of rejection.

However, as one of the references (U.S. Patent 6,798,767 to Alexander) is the same as in the previous rejection, Examiner has provided a response to the arguments relating to this reference herein. In the fourth paragraph of page 4, Applicant summarizes portions of the Alexander reference; this summary appears reasonable to the Examiner. In the next paragraph, Applicant states his opinion that the Alexander reference lacks many of the features of the claimed invention and draws conclusions that are incorrect. Applicant summarizes portions of the rejection made in the previous office action. Applicant then cites a passage from the specification and states that this distinguishes the invention from Alexander. However, Examiner disagrees. The Alexander reference discloses allocating both IP addresses as well as extensions to the telephone sets as has been clarified in the rejection provided herein.

In the next paragraph, Applicant summarizes portions of the claimed invention. Then, Applicant alleges that Alexander fails to show the transmitter, receiver, control circuit, and IP address allocation circuit configured and operating as described in the claims. However, these elements are disclosed in the combination of Alexander and Hamilton as explained in more detail in the rejection below.

The remainder of Applicant's arguments cover the Eastep reference and the combination of Alexander and Eastep. As Eastep is no longer used in the present rejection, these arguments are moot.

Claim Objections

2. Claim 12 is objected to because of the following informalities:

- In lines 5-6, the phrase “generates an ID comprising a domain name and an extension of the requesting telephone set” is ambiguous as it can have at least two meaning in light of the specification. It is not clear if the Applicant intends to claim (a) the generation of and ID which contains both a domain name and an extension, or (b) the generation of an ID which contains a domain name and the generation of an extension of the telephone set. The wording should be modified to clarify which of these two are being claimed.
- In lines 10-11, the phrase “a table that stores an ID comprising a domain name, an extension and the IP address” is also ambiguous. In light of the specification, it is assumed that the applicant intends that the table store the ID, the extension, and the IP address, where each of these three elements is described earlier in the claim. However, the way it is written, it could be read to mean that the table stores an ID, where this ID

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contains a domain name, and extension, and an IP address. This wording must be modified to clarify the claim. Examiner recommends that, at a minimum, “an ID” be changed to “the ID”, “a domain name” be changed to “the domain name”, and “an extension” be changed to “the extension”.

- In line 13, it is currently unclear to which ID (line 5 or line 10) the phrase “the ID” refers. However, if the suggested change regarding lines 10-11 is made, there will only be one “ID” in the claims and this objection will be overcome.

3. Claim 13 is objected to because of the following informalities: in lines 12-13, the phrase “generates an ID comprising a domain name and an extension of said at least on telephone set” is ambiguous as it can have at least two meaning in light of the specification. It is not clear if the Applicant intends to claim (a) the generation of and ID which contains both a domain name and an extension, or (b) the generation of an ID which contains a domain name and the generation of an extension of the telephone set. The wording should be modified to clarify which of these two are being claimed.

4. Claims 15-16 are objected to because of the following informalities: the limitation of claim 15 as worded is not supported in the specification. According to the specification (and as is well known in the art), “extension” refers to a telephone extension that may be a telephone number or an extension number in a PBX type system. In no way does this extension include a user name. The ID, however, may include a user name. Examiner assumes that Applicant intended to claim supported subject matter, such as the limitation “wherein said ID comprises an extension, a domain name and a user name.” The claim has been rejected assuming this

objection will be overcome with a similar limitation. Further, claim 16 is rejected as it depends from claim 15 and therefore also includes this limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **12-15 and 17-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,798,767 to Alexander et al in view of U.S. Patent 2006/0195540 to Hamilton et al.

Regarding claim **12**, Alexander discloses a telephone controller (the combination of the call manager 26 of figure 1 and the DHCP server implied in the passage from lines 20-23 of column 9) that controls plural telephone sets via LAN connected to the Internet (see figure 1 which shows a plurality of telephone sets connected to a LAN and the Internet), comprising: a receiver that receives a message sent via LAN by one of the telephone sets for requesting an IP address to be allocated for the requesting telephone set (see the passage in lines 20-23 of column 9; DHCP is a well-known protocol for allocating IP addresses; this passage describes that the telephony device gets its IP address using DHCP which clearly implies that the telephony device sends a DHCP request to a DHCP server which clearly must include a receiver to properly perform this IP address allocation); a control circuit that generates an ID and an extension of the requesting telephone set in case the message for requesting the IP address is received (see lines 26-29 of column 9; the call manager generates one or more extensions; one of these discloses the

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extension and the other discloses the ID); an IP address allocation circuit that allocates the IP address of the requesting telephone set (this is disclosed in lines 20-23 of column 9 which indicate that the DHCP protocol is used by the telephony device to obtain an IP address; clearly the DHCP server contains an address allocation circuit); a table that stores an ID, an extension and the IP address (the combination of tables 4A and 4B; Alexander indicates clearly in lines 15-20 of column 9 that these 2 tables may be combined into a single table); and a notifying unit that notifies the requesting telephone set of the ID, the extension and the IP address for the requesting telephone set (the passage from lines 20-29 of column 9 indicate that the telephony device is notified of both the assigned IP address as well as the assigned extensions (the ID and the extension of the claim language); this clearly requires a notifying unit to perform these functions).

Similarly, regarding claim 13, Alexander discloses a telephone communication system, comprising: a telephone controller (the combination of the call manager 26 of figure 1 and the DHCP server implied in the passage from lines 20-23 of column 9); a plurality of telephone sets which communicate with each other via a local area network (LAN) which is connected to the Internet (see the telephone sets shown in figure 1; these sets are connected to the Internet via a LAN); a transmitter associated with at least one of said plurality of telephone sets, said transmitter transmits via the LAN a message to said telephone controller requesting an Internet Protocol (IP) address be allocated to said at least one telephone set of said plurality of telephone sets (see the passage from lines 20-23 of column 9 DHCP is a well-known protocol for allocating IP addresses; this passage describes that the telephony device gets its IP address using DHCP which clearly implies that the telephony device sends a DHCP request to a DHCP server, which

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clearly requires a transmitter to send this message); a receiver associated with said telephone controller which received said message transmitted by said transmitter (see the passage in lines 20-23 of column 9; this passage describes that the telephony device gets its IP address using DHCP which clearly implies that the telephony device sends a DHCP request to a DHCP server which clearly must include a receiver to properly perform this IP address allocation); a control circuit associated with said telephone controller which, when said receiver receives said message transmitted by said transmitter, generates an ID and an extension of said at least one telephone set of said plurality of telephone sets (see lines 26-29 of column 9; the call manager generates one or more extensions; one of these discloses the extension and the other discloses the ID); an IP address allocation circuit associated with said telephone controller which, when said receiver receives said message transmitted by said transmitter, allocates said IP address requested by said at least one telephone set of said plurality of telephone sets (this is disclosed in lines 20-23 of column 9 which indicate that the DHCP protocol is used by the telephony device to obtain an IP address; clearly the DHCP server contains an address allocation circuit); a storage medium associated with said telephone controller which stores said IP address allocated by said IP address allocation circuit and said ID and said extension of said at least one telephone set of said plurality of telephone sets (the combination of tables 4A and 4B; Alexander indicates clearly in lines 15-20 of column 9 that these 2 tables may be combined into a single table; these tables are stored in memory 120 of figure 2); and a notifying unit associated with said telephone controller which notifies said at least one telephone set of said plurality of telephone sets of said ID (the passage from lines 20-29 of column 9 indicate that the telephony device is notified of both the

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assigned IP address as well as the assigned extensions (the ID and the extension of the claim language); this clearly requires a notifying unit to perform these functions).

Alexander does not disclose expressly the limitation that the ID generated by the control circuit (and subsequently stored in the table and notified to the telephone set) comprises a domain name. However, Hamilton discloses this limitation in the description of VPIM schemes in paragraphs 7-14 on pages 1-2. According to Hamilton, a VPIM id such as that in paragraph 10, can be used to send voicemail using an email application. This ID contains an extension and a domain name.

Alexander and Hamilton are analogous art because they are from the same field of endeavor of voice communications using data networks. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Alexander by changing one of the extensions (the ID in the rejection above) to use a VPIM format as indicated in paragraph 10 of Hamilton. The motivation for doing so would have been to allow a user to send a voicemail message to the telephony devices of Alexander using email. Therefore, it would have been obvious to combine Hamilton with Alexander for the benefit of enabling voicemail via email to obtain the invention as specified in claims 12 and 13.

Regarding claim 14, the combination of Alexander and Hamilton discloses the limitation that the domain name in the ID is a domain name of the telephone controller in that the call manager and the telephony device are on the same LAN and thus the same domain.

Regarding claim 15, the combination of Alexander and Hamilton discloses the limitation that the extension in said ID includes a user name in paragraph 16 of page 2. abc is the user name.

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Regarding claim 17, the combination of Alexander and Hamilton discloses the limitation that the telephone controller, when an incoming call is received, routes said incoming call to said at least on telephone set of said plurality of telephone sets based on said IP address stored in said storage medium in steps 200-208 of figure 5A.

Regarding claim 18, the combination of Alexander and Hamilton discloses the limitation that the storage medium stores said IP address and said ID in the form of a table in tables 120a and 120b of figures 4A and 4B.

Allowable Subject Matter

7. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if all claim objections listed herein are overcome.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent 5,974,453 to Andersen et al discloses a method for translating a static identifier including a telephone number into a dynamically assigned network address.
- U.S. Patent 6,600,734 to Gernert et al discloses an apparatus for interfacing a wireless local network and a wired voice telecommunications system.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 7:00-5:30 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RCS 1-29-07
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